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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,382	01/11/2002	Wendell W. Cattron	P 0283275 D1142	5496

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EXAMINER	
SERGENT, RABON A	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,382	CATTRON ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 8, 9, 12, 13, and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwalm et al. (US 2002/0058146).

Schwalm et al. disclose radiation curable compositions comprising a urethane acrylate, produced from the reaction of an aliphatic diisocyanate with a hydroxy functional acrylate, such as butanediol monoacrylate, and a diacrylate, such as butanediol diacrylate. See abstract and

paragraphs [0025] and [0037]. It is noted that both the butanediol monoacrylate and the butanediol diacrylate are disclosed as being preferred; therefore, the position is taken that the disclosure of these preferred compounds is adequate to anticipate applicants' claims. Schwalm et al. further disclose that at least one isocyanate functional component may be derived from aliphatic prepolymers derived from compounds such as ether containing compounds. See paragraphs [0020] and [0024]. This teaching is adequate to disclose the features of applicants' claims 12 and 13. The reference further discloses the use of photoinitiators and colorants. See paragraph [0039]. Lastly, the position is taken that the properties of claims 16 and 17 are inherently possessed by the disclosed compositions, since the respective compositions are produced from the same reactants, and therefore, are reasonably expected to possess equivalent properties.

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwalm et al. (US 2002/0058146) in view of Szum et al. ('750) or Tortorello ('547).

As aforementioned within paragraph 2, Schwalm et al. disclose radiation curable compositions comprising a urethane acrylate, produced from the reaction of an aliphatic diisocyanate with a hydroxy functional acrylate, such as butanediol monoacrylate, and a diacrylate, such as butanediol diacrylate. However, the reference fails to disclose the optical fiber applications of claim 20. Still, the use of analogous coating compositions in the production of optical fibers was known at the time of invention, as evidenced by the teachings of Szum et al. and Tortorello; therefore, as one of ordinary skill would have expected these analogous compositions to have equivalent utility, one of ordinary skill in the art would have been

motivated to utilize the compositions of Schwalm et al. in the treatment of optical fibers, so as to arrive at the instant invention.

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Szum et al. ('750).

Patentees disclose radiation curable coatings comprising urethane acrylate oligomers, considered to meet applicants' component (ii), and alkoxylated bisphenol A diacrylates, considered to meet applicants' component (i). See columns 3-8. Given applicants' disclosure at page 11, lines 13-15 of the specification, the position is taken that applicants' claimed bisphenol diacrylate (claims 5 and 6) encompasses the alkoxylated bisphenol diacrylates of Szum et al.

5. The examiner has reconsidered applicants' response, set forth within the amendment of January 7, 2004, to this rejection in view of the claims, as they are currently drafted. The position is taken that applicants' argument is no longer relevant to the current claims, because there is no requirement within the current claims that X_1 of formula (a) and X_1 of formula (c) be the same. Furthermore, it is by no means clear that the language of claims 2-4 excludes formula (c) species that correspond to the species of the reference.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
September 17, 2006

RABON SERGENT
PRIMARY EXAMINER